



Paper No. 9

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OFFICE OF PETITIONS

In re Application of:	:	
Stewart et al.	:	DECISION REFUSING
Application No. 09/785,693	:	STATUS UNDER
Filed: 16 February, 2001	:	37 C.F.R. §1.47(a)
Attorney Docket No. BEAS-01033US5	:	

This is in response to the petition under 37 C.F.R. §1.47(a)¹ filed herein on 20 July, 2001.

The petition is **DISMISSED**.

NOTE: Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" and may include an oath or declaration executed by the inventor.

Failure to respond will result in abandonment of the application.

¹ The regulations at 37 C.F.R. 1.47 provide:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).
[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

BACKGROUND

The record indicates:

- the application was filed on 16 February, 2001, without an executed oath or declaration;
- accordingly, a Notice to File Missing Parts of Application was mailed on 19 March, 2001, requiring an executed oath or declaration and a surcharge for the late filing;
- a petition, petition fee, a declaration executed by three of the four joint inventors, the surcharge for late filing, and a two month extension of time, were filed on 20 July, 2001 (with a certificate of mailing dated 18 July, 2001);

ANALYSIS

Petitioner has failed to:

- establish that the inventor has been presented with the full application and has refused to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events with support of the registered practitioner prosecuting this matter) or, despite diligent efforts, cannot be reached.

A copy of the application papers must be sent to the last known address of the non-signing inventor with a request that he/she sign the declaration for the patent application. Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address.

The documents submitted fail to establish that a full application, declaration, and assignment documents have been presented to the non-signing inventor, because it is unclear from Petitioner's statement where the package of documents sent by FedEx was shipped. Petitioner states that the papers were shipped to Mr. Metsaportti's "last known home address", but does not specify what that address is, while the petition later provides the "last known contact information" as an address in Finland. The FedEx

tracking document (Exhibit C) does not state where the package was delivered to.

In order to make the required showing, Petitioner should submit copies of the cover letter sent with the declaration and assignment documents and application papers, to clarify that the entire application, including the specification, claims, and drawings, was sent to the non-signing inventor. Further, documentation that shows the address to which the FedEx package was sent should be provided.

Further, the petition does not establish that diligent efforts were made to by obtain an accurate address, telephone number, or email address, in order to contact the non-signing inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Kathy Matecki at (703) 305-1645.



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